

REMARKS

This Response to the Office Action mailed April 2, 2009 is believed to address each and every issue raised in the Action. A favorable reconsideration of the application is respectfully requested.

Claim Status

Claims 11 and 20-36 are all the claims pending in the application. Claims 11, 26, and 35 are amended to more clearly set forth the claimed subject matter. Support for such amendment can be found in the specification, for example, pages 4-6, Example 2 and Figure 4. No new matter is added.

Statement of Substance of Examiner Interview

Applicants thank the Examiner for the telephone interview conducted on June 9, 2009. All of the pending claims were discussed. Applicant's proposed amendment to change the claim language from "consisting essentially of" to "composed of" was discussed and the Examiner indicated that "composed of" would be construed as "consisting essentially of", absent a showing from the specification that "composed of" should be construed differently. Applicants have considered the Examiner's remarks and respond below.

Claim Rejections - 35 U.S.C. § 103

On page 4, claims 11, 20-28, 35, and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paralkar (EP 1205189) in view of Tani et al (Bioorganic and Medicinal Chemistry, Vol. 10, pp. 1107-1114, 2002) and Fortier et al (J. Bone Joint Surg., Vol. 84-B, pp. 276-288, 2002).

Applicants submit that claims 11, 26, and 35 have been amended and the cited references fail to teach or suggest the present invention.

Currently presented claims 11, 26, and 35 and their dependent claims clearly set forth a method for treating cartilage-related diseases, which consists of administering a composition consisting of a substance having an EP2 agonist activity. Applicants point out that “[t]he transitional phrase “consisting of” excludes any element, step, or ingredient not specified in the claim.” *In re Gray*, 53 F.2d 520, 11 USPQ 255 (CCPA 1931). Paralkar is directed to a combination of prostaglandin agonist (including selective EP2 agonists) and a HMG-CoA reductase inhibitor, in which both compounds are essential active ingredients, and does not teach that the prostaglandin compound by itself is effective for treating cartilage-related disease, or that the EP2 agonist promotes the formation of cartilage by itself.

Although the specification indicates that the remedy of the present invention can be combined with other medicaments, the Examples demonstrate the unexpectedly superior results of using an EP2 agonist exclusively. (See Example 2 and Figure 4). Further, the instant specification makes no reference to the addition of any HMG-CoA reductase inhibitor or any other receptor agonist.

Additionally, Applicants respectfully traverse on the grounds that the Examiner has failed to present a prima facie case of obviousness. Specifically, the Examiner has failed to point out why one of ordinary skill in the art would have used a composition consisting of a substance having an EP2 agonist activity and a pharmaceutically acceptable carrier (i.e., not including HMG-CoA), in view of Paralkar’s combination therapy combining HMG-CoA with an EP2 agonist. Applicants assert that none of the Examples in Paralkar teach the exclusive use of an EP2 agonist for the treatment of cartilage-related diseases and thus one of ordinary skill would not have had a reasonable expectation of success.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the 35 U.S.C. § 103 rejection of claims 11, 20-28, 35, and 36.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

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